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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Frank J Viola

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60 Middletown Avenue
North Haven, CT 06473

EXAMINER

WOO, JULIAN W

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/510,165	Applicant(s) VIOLA, FRANK J	
	Examiner Julian W. Woo	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 31-37, 41, 43-50, 52, and 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shannon (3,653,389) in view of Wood (3,363,628). Shannon discloses the invention substantially as claimed. Shannon discloses, at least in the figures, a surgical apparatus including a handle portion (2 and 3 combined) including a moveable handle (3), an elongated body portion (4), and a jaw blade (5 and 6 combined) operably connected to the handle portion for selective closure (from fully open to fully closed and vice versa) upon an actuation of the moveable handle and including a first leg (5) and a second leg (5), each leg having a jaw (at 6) integrally connected thereto, and extending distally therefrom, the jaws defining a plurality of laterally-oriented channels and being configured to receive a surgical clip disposed

Art Unit: 3773

therebetween; and first and second inter-leg engaging members (8, 9) extending from one of the first and second legs, where when the interleg engaging member are engaged with the others of the first and second legs, a vertical displacement in a first direction of one of the first and second leg causes a first corresponding displacement in the first direction of the other of the first and second legs, and such that a vertical displacement in a second direction, opposite the first direction, of the one of the first and second legs causes a second corresponding displacement in the second direction of the other of the first and second legs, where the first and second interleg engaging members respectively comprise a first arm (8 or 9) having a tongue and a second arm (8 or 9) having a tongue, where the first and second legs each include an inner surface (at 7) and a recess (10) in an upper portion of the inner surface and engageable with a tongue, where the first arm closely overlies and is engageable the recess in the second leg and the second arm closely underlies and is engageable with the second leg, where a portion of the tongue of the first arm closely overlies the recess in a second upper surface of the second leg and a portion of the tongue of the second arm closely underlies the recess in a first lower surface of the first leg, where each of the first and second legs includes a neck (proximal of element 6) adjacent the jaw, where one inter-leg engaging member extends from the neck of the first leg and another extends from the neck of the second leg. However, Shannon does not disclose that each jaw defines a channel oriented substantially along a respective longitudinal axis thereof, where the apparatus is applicable for clip applying. Nevertheless, Shannon discloses, in col. 1, lines 51-62, that the jaw blade may be modified in "various forms...as may be best

Art Unit: 3773

suited to the conditions of a particular use," and Wood teaches a modification of jaws for use in clip application to blood vessels and other fluid ducts. Wood teaches, at least in figures 2 and 3 and in col. 3, lines 51-55 and col. 4, lines 7-30; jaws (19, 20) each defining a channel oriented substantially along a respective longitudinal axis thereof. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Wood, to modify the jaws of Shannon's device, so that the channel(s) are oriented substantially along a longitudinal axis of each of the jaws. Such an orientation of a channel would allow the firm gripping, orientation, and clamping of at least one surgical clip onto a blood vessel or other fluid duct within the narrow confines of surgical site.

3. Claims 31, 38, 42, 45, 47, 51, 56, 57, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitton, Jr. et al. (3,140,715) in view of Wood (3,363,628). Whitton, Jr. et al. disclose the invention substantially as claimed. Whitton, Jr. et al. disclose a surgical apparatus including a handle portion (13) including a movable handle (proximal, inclined portions of 11 and 12), an elongated body portion (elements 16), a jaw blade extending from the elongated body portion and operably connected to the handle portion for selective closure (from fully open to fully closed and vice versa) upon an actuation of the moveable handle and including a first leg (distal portion of 11) and a second leg (distal portion of 12), each leg having a jaw (14, 15) integrally connected thereto, and extending distally therefrom, the jaws defining channels (at 17 or 17') and being configured to receive a surgical clip disposed therebetween; and at least one inter-leg engaging members (20 or 22) extending from one of the first and

Art Unit: 3773

second legs, where the first leg includes a first arm (21) with a pair of transversely spaced apart tongues (22) where the second leg includes upper and lower surfaces (sides of 11) with respective upper and lower recesses (surfaces of 16 recessed with respect to sides of 11) engageable with the tongues. However, Whitton, Jr. et al. do not disclose that each jaw defines a channel oriented substantially along a respective longitudinal axis thereof, where the apparatus is applicable for clip applying. Wood teaches a modification of jaw channels for use in clip application to blood vessels and other fluid ducts. Wood teaches, at least in figures 2 and 3 and in col. 3, lines 51-55 and col. 4, lines 7-30; jaws (19, 20) each defining a channel oriented substantially along a respective longitudinal axis thereof. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Wood, to modify the jaws of the device of Whitton, Jr. et al., so that the channel(s) are oriented substantially along a longitudinal axis of each of the jaws. Such an orientation of a channel would allow the firm gripping, orientation, and clamping of at least one surgical clip onto a blood vessel or other fluid duct within the narrow confines of surgical site.

4. Claims 31, 33, 39, 40, and 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tartaglia (4,318,313) in view of Wood (3,363,628). Tartaglia discloses the invention substantially as claimed. Tartaglia discloses, at least in figures 1-7, a surgical apparatus including a handle portion (12 and 16 and 16' combined or 20 and 20') including a movable handle (16 and 16' or 20 and 20'), an elongated body portion (18, 18'), and a jaw blade including a first leg (10) and a second leg (10'), each

Art Unit: 3773

leg having a jaw (14 or 14') integrally connected thereto, and extending distally therefrom, the jaws defining channels (and 14 or 14') and being configured to receive a surgical clip disposed therebetween; and at least one or two inter-leg engaging members (30, 26, or 26 or 30', 26', or 26') extending from the first and second legs, where the jaw blade is assembled in a surgical clip applier (11); wherein when the jaws are in an open position, a portion of the inter-leg engaging member closely overlies and is slidingly engageable with a portion of the other of the first and second legs, where the first leg and the second leg includes respective first and second neck portions (at 20 and 20'), where an inter-leg member effects engagement with a first leg or second leg when the jaws are in an opened or closed position. However, Tartaglia does not disclose that each jaw defines a channel oriented substantially along a respective longitudinal axis thereof, where the apparatus is applicable for clip applying. Wood teaches a modification of jaw channels for use in clip application to blood vessels and other fluid ducts. Wood teaches, at least in figures 2 and 3 and in col. 3, lines 51-55 and col. 4, lines 7-30; jaws (19, 20) each defining a channel oriented substantially along a respective longitudinal axis thereof. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Wood, to modify the jaws of Tartaglia's device, so that the channel(s) are oriented substantially along a longitudinal axis of each of the jaws. Such an orientation of a channel would allow the firm gripping, orientation, and clamping of at least one surgical clip onto a blood vessel or other fluid duct within the narrow confines of surgical site.

Art Unit: 3773

5. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable Wood (3,363,628) in view of Shannon (3,653,389). Wood discloses the invention substantially as claimed. Wood discloses, at least in figures 3, 8, and 9 and in col. 1, lines 13-65 and col. 3, lines 51 to col. 4, line 6; a method for applying surgical clips and performing blunt dissection of tissue, where the method includes providing a surgical clip applier (19, 20) for applying surgical clips, performing a blunt dissection technique utilizing the jaws of the clip applier (i.e., inherent dissection of tissue surrounding a blood vessel or other fluid duct by insertion of the clip applier into a patient and by application of the clip with the jaws), and applying a surgical clip (25) to a tissue or vascular target area (e.g., 36) utilizing the clip applier, where the jaws each define a channel oriented substantially along a respective longitudinal axis thereof and are configured to receive the surgical clip. However, Wood does not disclose that the method includes a surgical clip applier including a handle portion including a moveable handle, an elongated body portion, and first and second legs and at least one inter-leg engaging member extending between the legs and effecting an engagement between the first and second legs, such that vertical displacement in a first direction of one of the first and second legs causes a first corresponding displacement in the first direction of the other of the first and second legs, and such that a vertical displacement in a second direction, opposite the first direction, of one of the first and second legs causes a second corresponding displacement in the second direction of the other of the first and second legs, and where the jaw blade is supported on a distal end of the elongated body and is selectively closed upon actuation of the moveable handle. Shannon teaches, at least in the figures

Art Unit: 3773

and in col. 1, lines 39-50, a forceps usable for the application of the clip of Wood's method, where the forceps includes a handle portion (2 and 3 combined) with a moveable handle (3), an elongated body portion (4) supporting a jaw blade (5 and 6 combined) with first and second legs that are selectively closed upon actuation of the moveable handle, jaws (at 6), and inter-leg engaging members (8, 9) as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Shannon, to modify the clip applier of Woods, so that it includes a handle portion, an elongated body portion, first and second legs and inter-leg engaging members as claimed. Such a clip applier would allow application of a surgical clip to a tissue, while allowing alignment of the jaws with respect to each other and preventing undue rocking motion of the jaws as the clip is manipulated with the applicator.

Response to Amendment

6. Applicant's arguments with respect to claims 31-60 have been considered but are not persuasive. That is, primary references Shannon; Whitton, Jr.; and Tartaglia indeed each disclose an apparatus including a handle portion having a movable handle, i.e., parts or sections of the apparatus that may be held or grasped and moved (via a hinged connection) to bring about selective closure of the jaw blade (opening and closing of the jaw blade).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 3773

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Julian W. Woo/

Primary Examiner, Art Unit 3773